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DOCKET NO. P21-164404M/ISI

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REMARKS

Claims 1-5, 8-9, 14-19, and 21-24 are all the claims presently pending in the application. Claims 25-28 have been canceled. Claims 1, 14, 16, and 23-24 have amended to more clearly define the invention. Claims 1, 14, and 23-24 are independent.

The amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability. Applicants also note that, notwithstanding any claim amendments made during prosecution of this application, Applicants' intent is to encompass equivalents of all claim elements.

Entry of this §1.116 Amendment is urged: The amendments narrow the issues for appeal, and are based on features and their distinctions over the prior art of record discussed earlier in the application prosecution. The amendments do not raise new issues nor require further search or consideration. As such, entry of this Amendment is believed proper and earnestly solicited.

Claims 1-5, 8-9, 14-19, and 21-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Bakker et al. reference.

This rejection respectfully is traversed.

I. THE CLAIMED INVENTION

An exemplary embodiment of the claimed invention, as recited by, for example, independent claim 1, is directed to a securing clip for securing a first panel member with a second panel member. The securing clip includes a first fitting portion having a U-character shape, and a second fitting portion having a U-character shape. The securing clip has an S-character shape in cross section. The second fitting portion includes a first engaging pawl on an inner wall face. The second fitting portion includes an engagement wall having an engagement face at an end of the engagement wall that faces an opening in the closed end of the U-character shape of the second fitting portion. A portion of the U-character shape second fitting portion, which is common to a portion of the U-character shape first fitting portion forming a middle of said S-character, includes a second engaging pawl opposing the first engaging pawl. A regulating wall of the second panel and the engagement wall are engaged. An engagement face of the regulating wall is inclined outwardly away from the opening in the closed end of the U-character shape of the second fitting portion in an

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insertion direction of the clip. Also, the engagement face of the engagement wall is inclined outwardly away from the opening in the closed end of the U-character shape of the second fitting portion.

II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

Claims 25-28 stand rejected based on alleged indefiniteness. Whereas Applicants' may disagree with the basis for the rejection, claims 25-28 have been canceled in an effort to advance prosecution.

In view of the foregoing, the Examiner respectfully is requested to withdraw this rejection.

III. THE PRIOR ART REJECTION

The Office alleges that Bakker et al. anticipates the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by the Bakker et al. reference.

A. The rejection fails as a matter of law:

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Office has not established that every element of the pending claims can be found in Bakker et al. Consequently, the rejection based on Bakker et al. fails at a matter of law.

B. The rejection fails as a matter of fact:

The proposed rejection based on anticipation fails as a matter of fact. Every element recited is not found in Bakker et al. Bakker et al. does not show the identical invention in as complete detail as is contained in the claims. Further, any elements that arguably may be shown in Bakker et al. are not arranged as required by the claims.

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For example, the Bakker et al. reference does not teach or suggest features of the claimed invention including an engagement wall having an engagement face at an end of the engagement wall that faces an opening in the closed end of the U-character shape of the second fitting portion and that is inclined outwardly away from the opening in the closed end of the U-character shape of the second fitting portion, wherein a regulating wall of a second panel and the engagement wall are engaged. As explained previously, these features are important for creating a wedge effect between the engagement face and a regulation wall of a fender protector which tightens the hold of the securing clip to the fender protector if a force attempts to separate the securing clip from the fender protector.

C. The Office action contains errors that affect Applicants' ability to reply:

The action contains errors that affect Applicants' ability to reply to the Office. Applicants respectfully request that the Office provide clarification as appropriate.

More specifically, the Office alleges, as to claim 1, that Bakker et al. discloses a securing clip capable of securing a first panel member with a second panel member. The securing clip is said by the Office to comprise a first fitting portion (18) having a U-character shape, and a second fitting portion having a U-character shape (22). Further, the Office contends that the securing clip is like an S-character in cross section (Fig. 4).

The Office goes on to allege that "each of the first fitting portion and the second fitting portion" comprises "an engaging pawl (23 and 34, respectively) on an inner wall face." Applicants note, however, that claim 1 does not recite "each of the first fitting portion and the second fitting portion comprising an engaging pawl on an inner wall face."

Instead, claim 1 recites "the second fitting portion comprising a first engaging pawl on an inner wall face." Further, claim 1 recites "a portion of said U-character shape second fitting portion, which is common to a portion of said U-character shape first fitting portion forming a middle of said S-character, comprises a second engaging pawl opposing said first engaging pawl."

Further error is presented in the Office's attempt to equate Bakker et al. with the rest of claim 1. To wit, the Office alleges that Bakker et al. discloses the second fitting portion comprising an engagement wall (32) having an engagement face at an end of the engagement wall that faces an opening in the closed end of the U-character shape of the second fitting portion (FIG. 5), and wherein a portion of said U-character shape second fitting portion (22), which is common to a portion of said U-character shape first fitting portion

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forming a middle of said S-character (12), comprises a second engaging pawl. Applicants note, however, that this description by the Office does not accurately correlate elements of FIG. 5 with the claim language.

Applicants note, in this regard, the explanation in the Office action that the two portions extending downwardly from portion 26 are considered to comprise a second engaging pawl. The Office has not explained, however, how the two portions extending downwardly from portion 26 can comprise the second engaging pawl, which, as recited in claim 1, is on "a portion of said second fitting portion, which is common to a portion of said first fitting portion forming a middle of said S-character." Indeed, portion 26 forms a part of the second fitting portion that is not "common to a portion of said first fitting portion forming a middle of said S-character."

Applicants note further that the Office action does not address all of the limitations of all of the claims. More specifically, the Office action does not point out, for example, where in the cited reference can be found limitations contained in examined claims 25-28, now canceled. These limitations have been incorporated in claims 1, 14, and 23-24, respectively. In particular, the limitations of claims 1, 14, and 23-24 (incorporated from canceled claims 25-28) relate to an engagement face of the regulating wall that is inclined outwardly away from the opening in the closed end of the U-character shape of the second fitting portion in an insertion direction of the clip. Lacking such disclosure in the cited prior art, the Office has not established *prima facie* that the references anticipate or render obvious the present invention as recited in the pending claims.

For these sufficient and other reasons, Applicants submit that Bakker et al. does not anticipate the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1-5, 8-9, 14-19, and 21-24, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

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Should the application be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 18 Jan 2007



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